

Serial No. 09/560,761
Group Art Unit: 1634

REMARKS / ARGUMENTS

Reconsideration of the present application is respectfully requested. Claims 22-26 and 31-33 remain in this application.

Claim 22 has been amended. Claims 25, 26, 31, 32, and 33 have been cancelled without prejudice. Support for the amendments resides throughout the specification and in the claims as originally filed. No new matter has been added by way of amendment to the claims.

It is respectfully requested that the amendments be entered.

Rejections under 35 USC §112

Rejections under 35 USC §112, first paragraph

5. Claims 22, 24, 25, 26, 31, and 33 are rejected under 35 USC §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Office Action states: "Claims 22, 24, and 25, and 26 recite a method for modulating the level of tocopherol in a plant which comprise stably transforming a plant cell with a polynucleotide selected from (iii) a polynucleotide having 70% sequence identity to SEQ ID NO:3 or (iv) a polynucleotide which selectively hybridized to SEQ ID NO: 3 under 'stringent conditions' and a given wash condition, or the complement of either of these polynucleotides. Claims 31 and 33 specify that the polynucleotide is that of option (iii) or (iv) respectively. However, within the broad genus of nucleic acids encompassed for use in the claimed methods, the instant specification only describes a single polynucleotide, that is SEQ ID NO: 3."

Claims 25, 26, 31, and 33 have been cancelled without prejudice.

Claim 22 has been amended to recite: "A method for increasing the level of tocopherol in a plant ... wherein the polynucleotide is selected from the group

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consisting of; i) a polynucleotide comprising the sequence set forth in SEQ ID NO:3 and ii) a polynucleotide that encodes the polypeptide of SEQ ID NO:4."

In view of the amendment, it is believed that one of skill in the art would reasonably conclude that the applicant was in possession of the claimed invention. Accordingly, this rejection should be withdrawn.

6. Claims 22-26 and 31-34 are rejected under 35 USC §112, first paragraph, because the specification does not reasonably provide enablement for claims broadly drawn to methods which utilize polynucleotides other than SEQ ID NO: 3 or methods which utilize SEQ ID NO: 3 or SEQ ID NO: 9 in the anti-sense orientation.

The Office Action states: "...[applicant] teaches soybean plants transformed with SEQ ID NO:3 (i.e., the polynucleotide encoding SEQ ID NO: 4) in the positive (sense) orientation.... Applicant provides the tocopherol/oil ration [sic] in somatic embryos produced from 33 transformation events.... Of the 33 ratios provided in Table 5, about a third of them were found to have tocopherol/oil ratios above the normal range. Applicant has thus demonstrated a method of increasing tocopherol levels in transgenic plants by transforming them with Instant SEQ ID NO:3...."

The Office Action further states: "The specification has not provided any examples of methods for reducing the level of phytyl/prenyltransferase protein in a plant or methods for modulating the level of tocopherol in a plant that utilize transformation of plant cells with antisense constructs."

Claims 25, 26, 31, 33 and 34 have been cancelled without prejudice.

Claim 22 has been amended to recite: "A method for increasing the level of tocopherol in a plant ... wherein the polynucleotide is selected from the group consisting of; i) a polynucleotide comprising the sequence set forth in SEQ ID NO:3 and ii) a polynucleotide that encodes the polypeptide of SEQ ID NO:4."


The amendment omits the limitation of "a polynucleotide complementary to a polynucleotide of (i) through (iv)". It is believed the amendment obviates the rejection.

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CONCLUSION

On the basis of the above amendments and remarks, reconsideration of the application and its allowance are respectfully requested.

Respectfully submitted,


Kathryn K. Lappegard
Agent for Applicant(s)
Registration No. 46,857

PIONEER HI-BRED INTERNATIONAL, INC.
Corporate Intellectual Property
7100 N.W. 62nd Avenue
P.O. Box 1000
Johnston, Iowa 50131-1000
Phone: (515) 253-5707
Facsimile: (515) 334-6883